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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/693,633	10/23/2003	Joseph S. Beda	3481	8889

7590 11/02/2005

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EXAMINER

WOODS, ERIC V

ART UNIT	PAPER NUMBER
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2672

DATE MAILED: 11/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action Before the Filing of an Appeal Brief	Application No.	Applicant(s)	
	10/693,633	BEDA ET AL.	
	Examiner	Art Unit	
	Eric V. Woods	2672	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 27 September 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☐ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☒ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____
Claim(s) objected to: _____
Claim(s) rejected: 1-62.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☒ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____
13. ☐ Other: _____.

Continuation of 5. Applicant's reply has overcome the following rejection(s): Rejections of claims 20 and 61 under 35 U.S.C. 112, second paragraph.

Continuation of 11. does NOT place the application in condition for allowance because: Applicant's arguments (page 5, first paragraph) that Geisler states that any art that "teaches away" in a material respect cannot be used in a rejection under 35 U.S.C. 103(a) is misplaced and inapposite. Geisler was directed to a situation where a three-layer film existed. The first reference taught the three layers, but not the desired thickness range. The second reference taught a range with an endpoint of "about 100 angstroms". In Geisler, the court found that this did not teach away from a lower thickness, even though the reference had an unstated assumption that the coating would be less effective at ranges below 100 Angstroms. The court further ruled that this did not constitute a 'teaching away' for several reasons. Note the court's citation of *In re Malagari*, 182 USPQ 549 (CCPA 1974), where this situation is also discussed and the concept of 'teaching away' is shown in be a high burden to meet. Finally, the court in Geisler failed to explicitly define the precise burden of 'teaching away' as contended by applicant. Therefore, for at least the above reasons, applicant's reliance on Geisler is not appropriate for this set of circumstances.

Applicant argues on page 4 that examiner has no motivation for combination but does not further discuss this point. Failure by applicant to make an attack on the motivation is noted. Examiner points out that the system of Itoh uses applets for navigating websites amongst other purposes. The system of Kim has a browser that accepts XML-based X3D markup language. Itoh uses markup language as noted. Applicant then assumes *arguendo* (bottom of page 4) that the combination is nonetheless valid and proceeds on to attack the Itoh reference.

Applicant then attacks the references in a piecemeal manner, particularly the Itoh reference. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

The Itoh reference may in fact translate markup language function calls to another format to be fed to the API, but applicant's claims do not require that the function calls be made natively to the API, that the markup language be the native format for the API or for the scene graph, or anything else. Also, applicant's claim clearly 'interpretes' the markup language -- which means that the markup language is then interpreted or translated to a lower level language and then compiled. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., directly sending the markup language to the API) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Lastly, it is further noted that the term 'via' is the only linkage between the function call (in markup format) and the API -- which clearly leaves the claim open ('comprising' language) to the addition of steps. Further, Itoh uses SVG data, as noted in the Final Office Action (2:19-28)). Very clearly, SVG data is well known in the art to have commands such as 'Animate' and the like -- see the SVG specification, the Steele reference, and all the discussions in the previous Office Actions on this topic. Very clearly, these would constitute function calls in and of themselves. X3D has similar functions with regard to animation and the like, which would constitute function calls, not merely the format of those in Kim, as applicant contends in Arguments page 5. Itoh has function calls from the markup language, as noted above -- all actions and visual representations exist within the X3D/SVG format and therefore, all changes to the scene graph and to the format generally come from the changes.

Lastly, it is noted that these rejections have been discussed with the primary examiner and 2600 QAS John Peng and have been found valid in the face of these arguments. Examiner will provide a more detailed version of the above explanations and much more in the Examiner's Answer.

Applicant's claim to domestic priority is denied. The specification in this case is significantly different than that of the parent case. Since this is a continuation-in-part, applicant is hereby required under 37 CFR 1.56 and to meet the standards of 35 USC 120 for CIP designation to disclose which claims have which priority date; that is, which claims are accorded the US filing date of the present application, and which claims are accorded the filing date of the parent. For all claims that have an alleged priority date of the parent case, applicant is required to show where in the specification of the parent support for such material is found. For now, all claims will be given the filing date of the US application. The burden is not on examiner to determine priority dates when the specification of the parent case and the instant case are significantly different (e.g. 100 pages for 10/401717 versus 118 pages for the instant application) with varying drawings, the burden is on applicant to prove which claims receive the parent filing date, since the case obviously has 18 pages of new matter added to it. It would be an extreme and undue burden on the Office for the determination to be made.

Finally, it is noted that should this series of rejections fall on appeal, prosecution will be re-opened and all claims will be rejected over the newly supplied references to Meyer et al (US 6,243,856) in view of Kim and/or French et al.

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PRIMARY EXAMINER